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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 09/462,717   | 04/10/2000  | Scott Olive          |                           | 5432             |
| 23446  | 7590        | 02/24/2006           |                           |                  |
| MCANDREWS HELD & MALLOY, LTD<br>500 WEST MADISON STREET<br>SUITE 3400<br>CHICAGO, IL 60661 |             |                      | EXAMINER<br>NGUYEN, KIM T |                  |
|  |             |                      | ART UNIT<br>3713          | PAPER NUMBER     |

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/462,717

Applicant(s)

OLIVE, SCOTT

Examiner

Kim T. Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 106-112 and 114-123 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 110 is/are allowed.
- 6) ☒ Claim(s) 106, 111 and 114-123 is/are rejected.
- 7) ☒ Claim(s) 107-109 and 112 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/6/05 &amp; 1/23/06</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Examiner acknowledges receipt of the amendment on 12/6/05. According to the amendment, claim 113 has been canceled, claim 123 has been added, and claims 106-112 and 114-123 are pending in the application.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 117 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed limitation "triggering a second game includes triggering a plurality of second games" is not disclosed in the specification.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 106, 111, 114-116, 118-120 and 122-123 are rejected under 35**

**U.S.C. 103(a) as being unpatentable over Luciano, Jr. et al (US patent No.**

**6,050,895) in view of Torango (US patent No. 6,592,460) and Place et al (US**

**5,707,285).**

Claim 106: Luciano discloses a network of gaming machines, each gaming machine include a user interface and accepts different wager amounts (col. 8, lines 48-63). The method for randomly awarding a prize using a second game upon an occurrence a trigger condition comprising making a wager and initiating a first main game (col. 4, lines 48-65); causing a second game trigger condition occurring as a result of the first main game having a probability of occurrence (col. 9, lines 1-3; col. 5, lines 63-66; col. 9, lines 27-32; col. 12, lines 46-48); triggering a second game in response to the trigger condition (col. 9, lines 4 1-45 and col. 6, lines 24-27); displaying the second game at the particular gaming machine (col. 10, lines 25-29); activating the user interface during playing the second game; and awarding the winning progressive prize to the player (col. 6, lines 56-63). Luciano does not explicitly disclose that the probability of trigger condition based on the amount of wager, the second game appears after completion of the main game, randomly selecting a prize and identifying the selected prize. However, since Luciano discloses that the number of potential trigger events increased by increasing the amount of wager (col. 9, lines 30-32), Luciano obviously encompasses teaching determining probability of trigger

condition based on the amount of wager. Torango, further, discloses determining probability (the odds) of triggering a bonus event based on the amount of wager (col. 24, lines 8- 10). Further, since Luciano discloses spinning the reels of the first game, evaluating the symbol combinations and paying award according to the result before starting a second game (col. 12, lines 44-46), since starting the first game, determining the result and awarding the player made a complete play of the first game, Luciano obviously discloses displaying the second game after completion of the main game. Luciano further discloses randomly selecting a prize (i.e. randomly select an outcome by spinning reels in a reel slot game, roulette wheel game, or a wheel of fortune game, etc.) (col. 6, lines 51-54) and Place et al discloses randomly selecting a prize from a plurality of prizes and identifying to the player the selected prize (col. 8, lines 11-14, and col. 6, lines 61-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine probability for triggering a second bonus game based on the amount of wager of Luciano as taught by Torango, and to randomly select a prize from a plurality of prizes that has been won as taught by Place in order to increase winning probability for the player who places large amount of wagers and to ensure providing a prize to the player who plays the bonus game .

Claim 111: since Tarango discloses generating a random number from a predetermined fixed range of numbers (col. 16, lines 4 1-53, 50-55; and col. 24, lines 13- 14), and since including a random number generator for generating random numbers would have been old and well known in the art, Torango obviously encompasses teaching including a random number generator in the game machine.

Place discloses the well-known random generator to generate random numbers (col. 6, lines 40-47). Further, initializing the random number generator at a desired time would have been well-known and obvious design choice and would requires only routine skill in the art according to the desire of a game designer.

Claim 114: Place discloses identifying occurs at the completion of the second game (col. 3, lines 63-65).

Claim 115-116: since Luciano discloses a reel slot machine having buttons and handle for the player to activate the reel slot game (Figs. 1A and 1B; col. 3, lines 23-26), Luciano obviously discloses including reels strips and user interface as claimed. Further, pressing buttons to stop the reels would have been well known to a person of ordinary skill in the art at the time the invention was made.

Claim 118: Since Torango discloses the gaming machine capable of accepting wager in different currency denomination (col. 4, lines 20-23), Torango obviously encompasses teaching currency denomination is one cent.

Claim 119: Place discloses unequal prize values (col. 7, lines 5-15).

Claims 120 and 122: providing prizes as a fraction of a pool, and alerting occurring of the second game prior displaying the second game would have been both well-known and obvious design choice.

Claim 123: Place discloses selecting a progressive prize after triggering a second game (col. 5, lines 58-59 and col. 6, lines 8-10).

**5. Claims 117 are 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano, Jr. et al (US patent No. 6,050,895) in view of Torango (US patent No. 6,592,460), Place et al (US 5,707,285) and Inoue (US 5,722,891).**

Claim 117: Inoue discloses triggering a plurality of second games (col. 6, lines 59-63). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a plurality of second games as taught by Inoue in the method of Luciano in order to impart further attractiveness to the game.

Claim 121: Inoue discloses providing a second game with higher probability of winning than the main game (col. 4, lines 66-67).

***Allowable Subject Matter***

6. Claim 110 is allowed.

7. Claims 107-109 and 112 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to show or fairly suggests a method of randomly awarding one progressive prize from a plurality of progressive prizes using a second game to select the progressive prize as set forth in the independent claim 110, or the combined claims 106 and 107 in which the steps of causing the occurrence of the second game trigger condition includes selecting a random number from a predetermined range of numbers; allotting a plurality of numbers from the

predetermined range of numbers in proportion to the amount of the wager made at the particular gaming machine; and indicating the occurrence of the trigger condition if one of the allotted numbers matches the selected random number.

***Response to Arguments***

8. Applicant's arguments filed 12/6/05 have been fully considered but they are not persuasive.
- a) Applicant's argument in page 8 through page 11, first paragraph, on claim 106, is moot in view of the new ground of rejection.
- b) Claims 107-110 and 112 are allowed over cited references, therefore, applicant's arguments in page 11 through page 13, lines 1-2, with respect to claims 107-110 and 112 are moot.
- c) In response to applicant's argument in page 13, first paragraph, through page 14, first paragraph, on claim 111, refer to the 35 USC 103(a) rejections on claim 111 above. Further, in col. 16, line 20, Torango discloses MR is the maximum number for the selection of the range of numbers. MR is not the range of numbers as asserted.
- d) In response to applicant's argument in page 14, second paragraph, on claim 117, refer to the 35 USC 103(a) rejections on claim 117 above. Further, the specification of the present application just includes 11 pages, page 12, lines 15-16 as asserted to support the limitation recited in claim 117 has not been found.



e) In response to applicant's argument in page 14, third and fourth paragraphs, on claims 121 and 123, refer to the 35 USC 103(a) rejections on claims 121 and 123 above.

f) In pages 15-16, applicant challenges a factual assertion of limitations of claims 109-110 and 113-122 as not properly officially noticed. However, the applicant does not adequately traverse such a finding. To adequately traverse such the finding, the applicant must specifically point out the supposed errors in the examiner's action, which would include stating with supporting facts why the noticed fact is not considered to be common knowledge or well-known in the art, and must prove that the limitation is actually an important inventive feature of present application. A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. See 37 CFR 1.111(b).

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any response to this final action should be mailed to:

Box AF:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

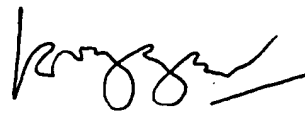
Or faxed to:

571-273-8300, (for formal communications; please mark  
"EXPEDITED PROCEDURE")

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (571) 272-4441. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on (571) 272-7147. The central official fax number is (571) 273-8300.

kn  
Date: February 14, 2006



Kim Nguyen  
Primary Examiner  
Art Unit 3713